

**Notice of Allowability**

Application No.

10/032,990

Applicant(s)

BOTSTEIN ET AL.

Examiner

Jeffrey Fredman

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to April 19, 2005.
2. ☒ The allowed claim(s) is/are 27-29,32-34 and 38-41.
3. ☒ The drawings filed on 27 December 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of the:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.  
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached  
1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.  
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☒ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____   | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                   |
| 4. <input checked="" type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|   | 9. <input type="checkbox"/> Other _____   |

JEFFREY FREDMAN  
PRIMARY EXAMINER

6/2/05

S.O.O

## **EXAMINER'S COMMENT**

### ***Inventorship***

1. In view of the papers filed April 19, 2005, the inventorship in this nonprovisional application has been changed by the deletion of

David Botstein, Luc Desnoyers, Sherman Fong, James Pan, Margaret Ann Roy, Timothy A. Stewart, and Daniel Tumas.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

### ***Deposit***

2. Claims 27 and 34 refer to specific ATCC deposits. These claims therefore require compliance with the deposit rules. 37 CFR 1.809 notes

"For each deposit made pursuant to these regulations, the specification shall contain: (1) The accession number for the deposit; (2) The date of the deposit; (3) A description of the deposited biological material sufficient to specifically identify it and to permit examination; and (4) The name and address of the depository."

The current deposit has the number and the date of deposit as well as the name of the depository, but does not include a description of the material or the address of the depository. Also, 37 CFR 1.808 requires that "a) A deposit must be made under conditions that assure that: (1) Access to the deposit will be available during pendency of the patent application making reference to the deposit to one determined by the Director to be entitled thereto under § 1.14 and

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**35 U.S.C. 122**, and (2) Subject to paragraph (b) of this section, all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of the patent.”

Therefore, in response to this notice of allowability, Applicant must amend the specification to include the address of the depository, and include a description of the deposited biological material. Also, Applicant must satisfy the Budapest treaty conditions and ensure that the deposit will be available for 30 years or 5 years since the most recent request and the requirement of 37 CFR 1.808(a) with a statement that all restrictions will be irrevocably removed upon granting of the patent.

### ***Reasons for Allowance***


3. The following is an examiner’s statement of reasons for allowance: The application expressly shows that the polypeptide, PRO982, is a mitogen which can induce cell proliferation, thereby providing a utility for the polypeptide and associated antigen. The Sequence encoding Seq ID NO: 9 and SEQ ID NO 8 itself are novel and unobvious over the prior art. There is no prior art that was identified which teaches either claimed sequence. Therefore, the claims are novel and unobvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey Fredman  
Primary Examiner  
Art Unit 1637  
6/2/05